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PATENT APPLICATION
SERIAL NO. 09/735,739

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Shantanu Sarkar et al.
Serial No. 09/735,739
Filing Date: December 12, 2000
Group Art Unit: 2616
Examiner: Shick C. Hom
Confirmation No. 7468
Title: METHOD AND APPARATUS FOR USING AN EXTERNAL
TRANSCODER IN A COMMUNICATION SESSION

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

REPLY BRIEF

In response to the Examiner's Answer dated October 29, 2007, Appellants respectfully submit this Reply Brief under 37 C.F.R. §41.41. Appellants filed an Appeal Brief on June 25, 2007 explaining clearly and in detail why the final rejections of Claims 1-5, 7, 9-13, 16-27, and 29-40 are improper and should be reversed by the Board of Patent Appeals and Interferences (the "Board"). In the Examiner's Answer, the initial rejections are sustained. This Reply Brief addresses responses made in the Examiner's Answer.

ARGUMENT

I. *The Examiner's Rejection of Claims 1, 3, 10, 16, 23, 25, 30, and 34-40 is Improper.*

As discussed in the Appellants' Appeal Brief at pages 11-12, Claims 1, 3, 10, 16, 23, 25, 30, and 34-40 are allowable at least because the Examiner fails to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the reference(s) must teach or suggest all elements of the rejected claims. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The Examiner's rejections fail to satisfy this requirement.

With respect to "communicating protocol capabilities to the station in response to initiation of the call" as recited in Claim 1, the Examiner argues that "Hild et al. in col. 5 line 49 to col. 6 . . . recite[s] the process for transcoder selection whereby the process begins by receiving a request corresponds to the communication being in response to initiation of a call as claimed." *Examiner's Answer*, p. 12. Appellants respectfully disagree. First, Claim 1 recites "communicating protocol capabilities to the station in response to initiation of the call." However, *Hild* discloses that "the request includes a set of characteristics." Col. 2, l. 17 (emphasis added). Second, Claim 1 recites "communicating protocol capabilities to the station in response to initiation of the call." *Hild* discloses that "client 400 sends a request to server 402 for content located in content database 404." Col. 4, ll. 50-51. "When the request is received, a transcoder is selected from transcoders 408 to translate content from content database 404 into a format for use by client 400." Col. 4, ll. 61-63. Contrary to the Examiner's assertion, *Hild* fails to disclose "communicating protocol capabilities to the station in response to initiation of the call," as recited in Claim 1. For at least these reasons, Appellants respectfully submit that the Examiner's rejection of Claims 1, 3, 10, 16, 23, 25, 30, and 34-40 is improper. Accordingly, Appellants respectfully request reversal of the Examiner's rejection and allowance of Claims 1, 3, 10, 16, 23, 25, 30, and 34-40.

With respect to "initiating a transfer of the call to the transcoder to establish a first link between the station and the transcoder; and initiating establishment of a second link with the transcoder to enable media exchange with the station using the protocol capability of the transcoder," as recited in Claim 1, the Examiner admits that *Hild* does not disclose these elements and relies on the Abstract of *Korpi*. The Examiner argues that "Korpi et al. in the

abstract recite[s] the use of a first and second link, i.e. a supervisory link and [] a media connection, respectively.” *Examiner’s Answer*, pp. 12-13. Appellants respectfully disagree. Claim 1 recites “to establish a first link between the station and the transcoder; and . . . establishment of a second link with the transcoder to enable media exchange with the station.” *Korpi* discloses “[p]rimary and secondary gatekeepers (104a, 106a) establish a supervisory link (1b) with one another while the media connection is set up between client terminals (112a, 114a).” *Abstract* (emphasis added). Contrary to the Examiner’s assertion, *Korpi* fails to disclose “a first link between the station and the transcoder; and . . . a second link with the transcoder,” as recited in Claim 1. For at least this reason, Appellants respectfully submit that the Examiner’s rejection of Claims 1, 3, 10, 16, 23, 25, 30, and 34-40 is improper. Accordingly, Appellants respectfully request reversal of the Examiner’s rejection and allowance of Claims 1, 3, 10, 16, 23, 25, 30, and 34-40.

For at least the reasons discussed above, the combination of *Hild* and *Korpi* fails to disclose, teach, or suggest all the limitations of Claims 1, 3, 10, 16, 23, 25, 30, and 34-40. Accordingly, Appellants respectfully request the Board to reverse the Examiner’s rejection of Claims 1, 3, 10, 16, 23, 25, 30, and 34-40 and direct the Examiner to issue a notice of allowance.

II. *The Examiner’s Rejection of Claims 2, 4-5, 7, 9, 11-13, 17-22, 24, 26-27, 29, and 31-33 is Improper*

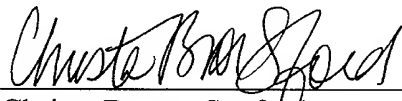
The Examiner rejects Claims 2, 4-5, 7, 9, 11-13, 17-22, 24, 26-27, 29, and 31-33 under 35 U.S.C. §103(a) as being unpatentable over *Hild*, *Korpi*, in view of *Eastep*. Claims 2, 4-5, 7, 9, 11-13, 17-22, 24, 26-27, 29, and 31-33 depend from and incorporate limitations of their respective independent claims, which are allowable for the above-discussed reasons. Therefore, dependent Claims 2, 4-5, 7, 9, 11-13, 17-22, 24, 26-27, 29, and 31-33 are allowable at least because they depend from an allowable independent claim. Accordingly, Appellants respectfully request the Board to reverse the Examiner’s rejection of Claims 2, 4-5, 7, 9, 11-13, 17-22, 24, 26-27, 29, and 31-33 and direct the Examiner to issue a notice of allowance.

CONCLUSION

Appellants have demonstrated that the present invention, as claimed, is patentably distinct from the cited references. Accordingly, Appellants respectfully request that the Board reverse the final rejection and instruct the Examiner to issue a Notice of Allowance of Claims 1-5, 7, 9-13, 16-27, and 29-40.

Appellants believe no fee is due; however, the Commissioner is hereby authorized to charge any fees or credits to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Appellants



Christa Brown-Sanford
Reg. No. 58,503

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Customer No. **05073**